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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,305	09/11/2003	Hideyo Osanai	117129	3571
25944	7590	08/09/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			TRAN, LEN	
			ART UNIT	PAPER NUMBER
			1725	
DATE MAILED: 08/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,305

Applicant(s)

OSANAI ET AL.

Examiner

Len Tran

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/21/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of group III, claims 7-9 in the reply filed on 6/10/05 is acknowledged. The traversal is on the ground(s) that group II, claim 10, should also be examined, since it the product can not be made by a different process. This is not found persuasive because the composite material of claim 10 can be made by injection molding process, not necessarily pouring of molten metal.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by (JP 07-276035) (IDS submitted by applicant).

As to claim 7, JP '035 discloses a method for manufacturing a metal-composite member comprising the steps of:

Placing a ceramic member (2) in a mold member (6);

pouring molten metal (1) to be joined into the mold member (6) so as to bring the molten metal into contact with the surface of the ceramic member;

cooling and solidifying the molten metal to join the metal onto the surface of the ceramic member by a direct joining strength of the ceramic and the metal on an interface therebetween,

wherein the molten metal to be joined is poured while the mold member is passing through a passage member, *with the ceramic member placed in the mold*, extending along a plurality of process regions, practically in a shielded state from the atmosphere [(figure 1) (abstract), (page 2, [0008]), (page 4, [0015]) and (last line of page 4)].

As to claim 8, the solidification is made to progress in one direction when the molten metal is cooled and solidified as shown in figure 1.

As to claim 9, wherein the metal is aluminum (page 1, claim 6) and the ceramic member is a carbide (page 1, claim 6).

Response to Arguments

3. Applicant's arguments filed 6/10/05 have been fully considered but they are not persuasive.

As to section IV of applicant's argument, applicant argues that JP '035 fails to teach "wherein the molten metal to be joined is poured while the mold member is passing through the passage member, with the ceramic member placed in the mold". Examiner respectfully disagrees. JP '035 discloses a ceramic member (2) within the mold (6). The mold (6) as shown in figure 1, is passing through a passage member (not shown), since the mold needs a structure to

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hold it in place. The ceramic member (2) is always in the mold (6) until after solidification of the metal around the ceramic member then the product (metal-ceramic composite) is taken out of the mold. Therefore, based on the broadest interpretation of the claims, the prior art, JP '035 discloses the claimed invention as claimed.

It is understood from applicant's specification that the method comprises steps of pouring the molten metal to a movable mold, containing a ceramic member therein, wherein the movable mold is disposed inside a fixed mold. However, such language is not in the claimed invention. Therefore, claims 7-9 remain rejected.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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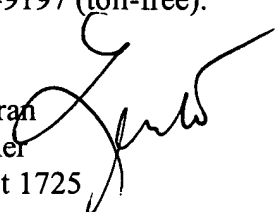
Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Len Tran whose telephone number is (571) 272-1184. The examiner can normally be reached on M-F, 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Len Tran
Examiner
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August 6, 2005